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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,235	10/11/2000	Frederic L. Way II	TS097-cipSLED	6103

7590

11/24/2003

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EXAMINER

KLEBE, GERALD B

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/686,235

Applicant(s)

WAY ET AL.

Examiner

Gerald B. Klebe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 0200 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

11/13/03

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. The amendments filed 6/24/2002 (Paper No. 5) and 9/05/2003 (Paper No. 9) under 37 CFR 1.111 have been entered. Claims 1-28, as amended, are pending in the application.

Restriction/Election

2. Applicant's election with traverse of inventive species Group IV, Fig. 12 of an embodiment of a gravity driven steerable vehicle with skis mounted both front and rear (Paper No. 5) is acknowledged.

Applicant traverses the restriction requirement, contending that each species is patentably distinct and each is defined by each and all of the claims as filed and as amended. However, Applicant has provided no persuasive argument(s) for withdrawal of the restriction requirement while stating that the species are patentably distinct. These arguments are unpersuasive in traversing the restriction requirement, and in light of regulations requiring one invention per patent (refer MPEP Sec. 803.01), the restriction requirement is therefore held to be proper and is hereby maintained.

Applicant further identifies claims 8-10, 12, 14, 16-19, 27, and 28 as reading on the elected species Group IV, Fig. 12.

The examiner disagrees that claims 8-10, 12, 14, and 16-19 apply to the elected species. The examiner holds that claims 1-19 are not readable on the elected species of Fig 12 for a gravity driven steerable vehicle with skis mounted both front and rear.

The examiner notes that claim 1 comprises recitations of structures applicable to a wheeled vehicle as evidenced in the recitations: line 8 "...means for steering said gravity driven steerable

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wheeled vehicle...”; line 10 “...at least one but not more than two rear wheel hub and spindle assemblies...”; line 12 “... at least one but not more than two front wheel hub and spindle assemblies...”; and other such recitations that recite structures of a non-elected species. Claims 2-19 being dependent upon claim 1 carry the same recitations. Therefore, the examiner holds that claims 1-19, being drawn to a non-elected species are withdrawn from further consideration.

Furthermore, besides claims 27 and 28, indicated by the Applicant to be readable upon the elected species, the examiner further recognizes claims 20-26 to read thereon as well. Therefore, the examiner holds claims 20-28 to be readable on the elected species of Fig 12.

Drawings

4. a. The drawings filed 10/11/2000 are informal and are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
- b. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include numerous reference numbers not identified in the specification. Correction is required.
- c. The drawings are further objected to for having numerous informalities. Some examples are as follows:

Fig 2: - the same numeric designator 13 is used to point to various different structures of the vehicle;

- the numeric designator 10 is used to point to different structures depicted in the figure;
- numerics 11.000, 17.837 and 20.000 appear to represent dimensions of the object rather than to be designators of parts of the structure.

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Other examples exist; correction is required prior to allowance of the application.

d. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features of claims 24-27 reciting limitations of means for absorbing shock exerted on the ski must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification--Objections

5. The specification is replete with terms which appear not to relate to the subject of the inventive concept. The specification should be scrutinized for errors and revised carefully in order to comply with 35 U.S.C. Sec. 112. Examples of some errors and unclear or inexact terms used in the specification are as follows:

- page 7, line 5 refers to a wheeled vehicle whereas the invention relates to a vehicle supported front and rear on skis/runner and having no wheels; the following text also appears to apply to a wheeled vehicle rather than a vehicle used on a snow surface;
- page 7, lines 28-29 relates to braking of wheels of the vehicle.

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Other errors, inconsistencies and informalities exist. The entire specification should be scrutinized to remove such informalities and unclear/confusing statements. Appropriate correction or clarification is required.

Claim Objections – Minor Informalities

6. The claims are objected to for the following informalities:

Claims 24-27: the word “skiis” should be -- skis --;

Claim 26, in line 3: the number “1” appearing between “front” and “hub” is improper.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 20 is rejected under 35 U.S.C. 102 (b) as being anticipated by Volz (US 1409501).

Volz discloses a gravity driven steerable vehicle for use on snow covered terrain comprising: (**re: claim 20**) a chassis (1) having a front, rear , and underside and a topside; a rider riding surface on the top side configured to cause a rider on the surface to be oriented in a prone, face down, face forward position (refer lines 61-66); means (2) for attaching a rear axle assembly (3) substantially at the chassis rear (refer lines 35-37); means (5) for mounting a front axle assembly (6) at the chassis front (refer lines 37-40); means (5) for steering the vehicle by the rider (refer lines 61-66); two rear hub and spindle assemblies (11, 12 and 14 (refer lines 51-57); wherein the ends of the axles 3, 6 serve as spindles (refer lines 42-46)); refer lines 47-48) integral with the rear axle assembly, one rear hub and spindle assembly at each end of the rear

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axle assembly; and two front hub and spindle assemblies integral with the front axle assembly, one front hub and spindle assembly at each end of the front axle assembly; and means for attaching one ski (10) assembleable to each of the two rear hub and spindle assemblies and to each of the two front hub and spindle assemblies (refer lines 46-61).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Redling (US 2353501).

As discussed above, Volz discloses all of the features of claim 20 from which claim 21 depends. Volz lacks explicit disclosure of a braking feature.

Redling teaches a snow sled having a manually actuated brake (combination 42, 43, 44).

It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volz to incorporate a hand brake in accordance with the teachings of Redling as a safety feature to keep the sled stationary when the rider was entering or exiting from the sled as suggested by the reference at column 1, lines 41-45.

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Dandurand (US 2770465).

As discussed above, Volz discloses all of the features of claim 20 from which claim 22 depends. Volz lacks explicit disclosure of a harness for the rider.

Dandurand teaches a harness (24) for securing a rider onto the riding surface of a sled.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volze to incorporate a harness in accordance with the teachings of Dandurand in order to secure the rider onto the riding surface as a safety measure and to provide a more comfortable ride during maneuvers.

12. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Gibbons (US 6116622).

As discussed above, Volz discloses all of the features of claim 20 from which claim 28 depends. Volz lacks explicit disclosure of a combination roll bar and tote bail for sled.

Gibbons teaches a roll bar and bail (32) for a snow sled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volz to incorporate a combination roll bar and tote bail in accordance with the teachings of Gibbons in order to provide safety in case of sled overturning during riding and whereby the sled could be at least partially lifted for transport when not being used.

13. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Redling (US 2353501) and further in view of Dandurand (US 2770465).

As discussed above, the combination of Volz and Redling discloses all of the features of claim 21 from which claim 23 depends. The combination of Volz and Redling lacks explicit disclosure of a harness for the rider.

Dandurand teaches a harness (24) for securing a rider onto the riding surface of a sled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of the combination of Volz and Redling to incorporate a harness in accordance with the teachings of Dandurand in order to secure the rider onto the riding surface as a safety measure and to provide a more comfortable ride during maneuvers.

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14. ~~Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Redling (US 235501) and further in view of Dandurand (US 2770465).~~

As discussed above, the combination of Volz and Redling discloses all of the features of claim 22 from which claim 23 depends. The combination of Volz and Redling lacks explicit disclosure of a harness for the rider.

Dandurand teaches a harness (24) for securing a rider onto the riding surface of the sled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of the combination of Volz and Redling to incorporate a harness for the rider in accordance with the teachings of Dandurand in order to secure the rider onto the riding surface as a safety measure and to provide a more comfortable ride during maneuvers.

15. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Berthold et al. (US 4291892).

As discussed above, Volz discloses all of the features of claim 20 from which claim 24 depends. Volz lacks explicit disclosure of shock absorbing means between the front attached skis and the front axle assembly.

Berthold et al. teaches a gravity driven steerable snow vehicle having shock absorbing means between the front skis and the front axle assembly.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volz to have shock absorbers on the front skis between the skis and the axles in accordance with the teachings of Berthold et al. in order to cushion the ride over uneven terrain as suggested by the reference at column 1, lines 22-27.

16. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Dandurand (US 2770465) in further view of Berthold et al. (US 4291892).

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As discussed above, the combination of Volz and Dandurand discloses all of the features of claim 22 from which claim 25 depends. The combination of Volz and Dandurand lacks explicit disclosure of shock absorbing means between the front attached skis and the front axle assembly.

Berthold et al. teaches a gravity driven steerable snow vehicle having shock absorbing means between the front skis and the front axle assembly.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the instant invention was made to have modified the sled of the combination of Volz and Dandurand to have shock absorbers on the front skis between the skis and the axles in accordance with the teachings of Berthold et al. in order to cushion the ride over uneven terrain as suggested by the reference at column 1, lines 22-27.

17. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Volz (US 1409501) and Redling (US 2353501) in view of Dandurand (US 2770465) and further in view of Berthold et al. (US 4291892).

As discussed above, the combination of Volz, Redling and Dandurand discloses all of the features of claim 23 from which claims 26 and 27 depend. The combination of Volz, Redling and Dandurand lacks explicit disclosure (re: claim 26) of shock absorbing means between the front attached skis and the front axle assembly.

Berthold et al. teaches a gravity driven steerable snow vehicle having shock absorbing means between the front skis and the front axle assembly.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the instant invention was made to have modified the sled of the combination of Volz, Redling and Dandurand to have shock absorbers on the front skis between the skis and the axles in accordance with the teachings of Berthold et al. in order to cushion the ride over uneven terrain as suggested by the reference at column 1, lines 22-27.

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Regarding the further limitations of Claim 27, wherein the sled has shock absorbing means between the skis and the axle assembly attached to each of the two rear hub and spindle assemblies, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have further modified the sled having shock absorbing means attached between the skis and axle assemblies at the front of the sled to include, as well, shock absorbing means attached between the skis and axle assemblies at the rear of the sled since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

Claims Rejections - Double Patenting

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

19. Claims 20-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, and 9 of U.S. Patent No. 6,276,700 in view of Volz (US 1,409,501).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences, using skis instead of wheels as the support elements for the vehicle, represent obvious modifications taught by Volz (-501) wherein it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have

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substituted skis in place of the wheels at the front and rear of the vehicle as suggested by Volz at lines 11-20.

Prior Art made of Record


20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of Heine teaches a wagon to sled conversion kit with front steering; Frejaville teaches a gravity driven steerable vehicle with front steering and braking and hand hold for the prone rider; Krausz teaches a brake assembly for a skateboard; Reid, Jr. teaches a wheeled sled with front steering, front braking, hand grips for the prone rider and front and rear wheels mounted on solid axles; Way et al. teaches a gravity driven steerable wheeled vehicle. These references also teach various other structures having features in common with some of the limitations disclosed in the instant application


Conclusion

21. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 703-305-0578, fax 703-872-9326, M-F 8:00 AM- 4:30 PM ET, or to Supervisory Patent Examiner Brian L. Johnson, Art Unit 3618, at 703-308-0885.

Note that the examiner's fax number has changed.

Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.


gbklebe / Art Unit 3618 / 13 November 2003


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11/14/03